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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,447	09/13/2000	Helen B. McIntosh	T2739-906589	7855
7590 06/21/2006 HUSCH & EPPENBERGER, LLP 190 CARONDOLET PLAZA SUITE 600 ST. LOUIS, MO 63105-3441			EXAMINER SUHOL, DMITRY	
			ART UNIT 3725	PAPER NUMBER

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/661,447	<b>Applicant(s)</b> MCINTOSH, HELEN B.	
	<b>Examiner</b> Dmitry Suhol	<b>Art Unit</b> 3725	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 47-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 47-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erumsele '631 in view of Joyce '000. Erumsele discloses an article of manufacture containing most of the elements of the claims including, a rectangular rug (portable covering) which is lightweight and portable (figure 1, rug 2 described at col. 2, lines 14-18 and lines 22-23) as required by claims 47, 53, 57, 60, 62, 66, 70, 73. Regarding claims 49-50, 60, 63 Erumsele is considered to encompass the claimed limitations as shown in figure 1 and described at col. 2, lines 8-10 where a color associated with water is considered to be peaceful and neutral as claimed. Regarding claims 54, 67, as the dimensions as broadly claimed are considered to be encompassed by the Erumsele in figure 1. Regarding claims 58-60, 71-73, it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to have manufactured the floor covering of Erumsele from a synthetic soft, pliable yarn since the reference clearly teaches that the covering may be made of any synthetic material and may be a rug (col. 2, lines 14-18), where the examiner takes official notice the use of synthetic soft and pliable yarn in rug manufacturing is well known in the art.

Erumsele fails to explicitly disclose a first and second set of instructions as required by claims 47-48, 51-52, 60-62, 64-65, 73. Joyce discloses a game, which teaches that it is known to provide game amusement devices with a printed set of instructions (80) for the purpose of setting forth the rules of the game (Joyce, col. 5, lines 60-61). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to have provided instructions with the article of Erumsele for setting forth the rules of the game. Furthermore it should be noted that it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983) and *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of instruction does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. script text) and the substrate (e.g. instructions 4) which is required for patentability.

Regarding the specific rug dimensions and shapes as required by claims 55, 60, 68, 73, it would have been obvious to manufacture the rug game board of Erumsele with dimensions of approximately 2 feet by 3 feet, approximately 3 feet by 5 feet or approximately 4 feet by 6 feet for the purpose providing a good mix of size, portability and storability, especially since Erumsele clearly states at col. 4, lines 6-9 that her rug may be any dimension in length and wide enough such that players may pass each

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other without interference both of which would be encompassed by the above dimensional limitations of the above claims and since Erumsele is clearly concerned with portability and storability of her game. Furthermore, the specific size of the rug is considered to be a design choice in that applicants clearly state that at page 6, lines 20-21 that the rug may be made of any shape, size and material suitable for carrying and handling.

Regarding claims 56, 69 the circular shape and claimed diameter of 3, 4 or 5 feet, the specific shape and size of the rug/floor covering is considered to be a design choice in that applicants clearly state that at page 6, lines 17-31 that the rug/floor covering may be made of any shape, size and material suitable for carrying and handling, additionally it should be noted that examiner takes official notice that rugs with a circular shape and above claimed dimensions are well known in the art.

Claims 47-49, 51-54, 62-67 rejected under 35 U.S.C. 103(a) as being unpatentable over Roggero '387 in view of Joyce '000. Roggero discloses most of the claimed elements including a rectangular portable floor covering which is lightweight and portable (figure 1, playing board) as required by claims 47, 53, 62, 66. Regarding claims 49, 63 Roggero is considered to encompass the claimed limitations as shown in figure 1 and described at col. 3, lines 54-60. Regarding claims 54, 67, as the dimensions as broadly claimed are considered to be encompassed by the Roggero in figure 1.

Erumsele fails to explicitly disclose a first and second set of instructions as required by claims 47-48, 51-52, 62, 64-65. Joyce discloses a game, which teaches that it is known to provide game amusement devices with a printed set of instructions (80) for the purpose of setting forth the rules of the game (Joyce, col. 5, lines 60-61). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to have provided instructions with the article of Roggero for setting forth the rules of the game.

### ***Response to Arguments***

Applicant's arguments filed 8/26/2005 have been fully considered but they are not persuasive. Applicants argue that the examiner has failed to establish a case of prima facie obviousness since, according to the applicants, the Erumsele and Joyce references are not analogous art to the applicants invention. In response the examiner points out that applicants kit is a floor covering (may be a rug) and a set of instructions for its use (facilitating conflict resolution). While Erumsele '631 clearly discloses a game that has a rug/floor covering where a set of instructions would have been clearly obvious to one having ordinary skill in the art as games, where a game as shown can broadly be called a conflict resolution area since when children are playing whatever conflict they may have is quickly forgotten or put aside. Additionally, it should be restated that the courts have recently held that a kit which differs from prior art in a manner of use as demonstrated by a set of instructions is **NOT patentable** in a product type claim and should rather be directed to a method patent. *In re Ngai*, 367 F.3d 1336,

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70 USPQ2d 1862. Furthermore it has been held that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In this case the game of Erumsele is clearly capable of functioning as a system for conflict resolution since two members playing a game can easily overcome their differences. Therefore it is the position of the examiner that Erumsele obviates applicants current claims.

Applicants further argue that the instructions have a functional connection to the floor covering/rug and therefore case law of *Gulack* and *Ngai* do not apply to the currently claimed invention. In response the examiner points out in *In re Gulack* and in *In re Miller*, 164 USPQ 46 (CCPA 1969) the courts have clearly established that there **MUST** be a functional relationship between the printed matter and the substrate, that is to say that the indicia of *Gulack* and *Miller* would be rendered useless if not placed upon the respective specific substrate. In other words the indicia of *Gulack* would not function if it were not for the structure of the endless loop of the *Gulack* band and the indicia of *Miller* would be rendered useless if it were placed upon a different substrate. Regarding *In re Ngai*, 70 USPQ2d 1862 (Fed. Cir. 2004), the case shows that two identical structural elements are not patentable over each other solely based upon the

instructions provided therewith even if a different use is intended but rather must be presented in a method claim in order to have patentable merit. In this case, applicants make it clear in their disclosure that at page 6, lines 17-31 that the invention does not lie with the rug, sheet or other floor covering but rather a defined conflict resolution area and script uttered by the participants. Thus the instructions/script are in no way connected to the particular floor covering, rug, etc and may be used with any other device as long as it can define a resolution area and are therefore not functionally related. Furthermore, the combination of references of Erumsele and Joyce clearly obviate/anticipate applicants invention when looked upon in light of *In re Ngai*.

Applicants further appear to argue that Erumsele fails to disclose colors which are tranquil and calming. In response the examiner points out that Erumsele colors relate to a nature scene which most find very peaceful and calming and therefore read on the claimed limitations.

Applicants further argue that the instructions of Joyce do not teach self-expression or conflict resolution. In response the examiner points that Joyce is merely relied upon to teach that providing printed instructions in an environment such as Erumsele is known, while the content of the instruction can not serve to patentably distinguish in a kit claim which discloses the claimed structure as decided by the courts. *In re Ngai*.

Applicants have failed to patentably distinguish their claimed invention structurally from the prior art. The functionality of the structure can not serve to distinguish the invention if the prior art is capable of fulfilling the claimed function. Here



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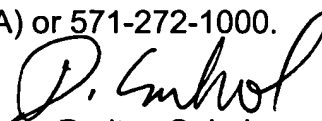
the kit has a floor covering/rug which serves as a conflict resolution area and a set of instructions. The rug of Erumsele is clearly capable of functioning as a conflict resolution area while the set of instructions does not patentably distinguish the invention.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Dmitry Suhol

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Primary Examiner  
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